

## **REMARKS**

In the Final Office Action dated April 10, 2006, the Examiner rejected claims 1-3, 7-13, 17-23 and 27-30 under 35 U.S.C. § 102(b) as being anticipated by Walker et al. (U.S. Patent Number 6,018,718) (Walker) and rejected claims 4-6, 14-16 and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Walker.

By this amendment, Applicants propose to amend claims 1, 4, 6, 7, 11, 14, 16, 17, 21, 24, 26, and 27. No new matter has been added. Indeed, the proposed independent claims 1, 11, and 21 include recitations already considered and examined by the Examiner. For example, these claims now recite a payment due date, which was considered by the Examiner in response to the rejection of claims 4, 6, 14, 16, 24, and 26, for example. Accordingly, Applicants submit that the proposed amendment does not require additional consideration or search beyond that already performed by the Examiner, and thus should be entered by the Examiner.

In light of the foregoing amendments and based on the arguments presented below, Applicants respectfully traverse the rejections of claims under 35 U.S.C. §§ 102(b) and 103(a), and request allowance of claims 1 through 30.

### **I. Rejections Under 35 U.S.C. 102(b)**

Applicants respectfully traverse the rejection of claims 1-3, 7-13, 17-23 and 27-30 under 35 U.S.C. § 102(b) as being anticipated by Walker. A proper anticipation rejection requires each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference. See M.P.E.P § 2131. The anticipation rejection set forth in the Office Action does not properly establish that each and every claimed element of the rejected claims is found in Walker.

First, claims 1-3, 7-13, 17-23, and 27-30, as amended, recite, *inter alia*, determining reward points based on the reward incentive parameter of a predetermined payment due date. In rejecting claim 4 (and addressing similar recitations), the Examiner asserts, that Walker indicates that the payment due date is a valid criteria for performance rewards. However, Walker discloses only a “target period” of time during which the credit-card holder must achieve the reward-earning behavior (Walker, Col. 6, Lines 8-10). In addition, all performance measurements are based on revenue contributors (i.e., dollar values and usage levels) (Walker, Col 6, Lines 22-25 and Col 8, lines 4-6). Walker does not teach, suggest or otherwise disclose the use of a date of any kind as the defined target measurement for determining the earning of reward points.

Further, the Examiner asserts that Walker discloses “...that the payment due date is a valid criteria for performance rewards. (Col 7, lines 61-67 and Col 8, lines 51-60).” However, Walker does not teach the use of a payment due date for determining reward points in a manner consistent with the recitations of independent claims 1, 11, and 21. Further, the passage of Walker cited by the Examiner discusses the creation of a “behavior score” that may be based, in part, on “promptness of payment.” Walker, however, does not teach, suggest or otherwise disclose the use of this “behavior score” or payment due date as a performance target measurement for the determination of reward points. This “behavior score” is merely used as a market-segmenting tool to determine which performance targets should be offered to which credit-card holders.

Accordingly, Walker does not support the rejection of independent claims 1, 11, and 21 because the cited art fails to teach or suggest each and every recitation of these

claims. Accordingly, because the Examiner has not established a *prima facie* case of anticipation, the rejection of these claims should be withdrawn and the claims allowed.

Claims 2-10, 12-20, and 22-30 depend from claims 1, 11, and 21, respectively. As explained, the cited art does not support the rejection of independent claims 1, 11, and 21. Therefore, the cited art does not support the rejection of their respective dependent claims 2-10, 12-20, and 22-30 for at least the same reasons set forth in connection with claims 1, 11, and 21. Thus, the rejection of these claims should be withdrawn and the claims allowed.

## II. Rejections Under 35 U.S.C. 103(a)

Applicants respectfully traverse the rejection of claims 4-6, 14-16 and 24-26 under 35 U.S.C. § 103(a) as unpatentable over Walker because the Examiner has not established a *prima facie* case of obviousness as required under 35 U.S.C. § 103(a).

“To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Claims 4-6, 14-16, and 24-26 depend from claims 1, 11, and 21. As explained, Walker, does not support the rejection of these independent claims. Therefore, the cited art does not support the rejection of their respective dependent claims 4-6, 14-16, and 24-26 for at least the same reasons set forth in connection with independent claims

1, 11, and 21. Thus, the rejection of these claims should be withdrawn and the claims allowed.

Further, the rejection of dependent claims 4-6, 14-16, and 24-26 is improper because the motivation to modify Walker is lacking. For example, in rejecting claims 4, 6, 14, 16, 24, and 26, the Examiner alleges it would have been obvious to one of ordinary skill in the art to modify Walker “to create an environment in which corporate cash flow and working capital could be accurately predicted.” (OA at 10.) This reason, however, does not reasonably address the recitations of claim 4, for example, nor is it supported by the cited art in relation to the teaching the Examiner asserts Walker discloses to suggest Applicants’ claims.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that a “prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Certainly, as noted in M.P.E.P. § 2143.01, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” Accordingly, the Examiner has not shown why a skilled artisan would have altered Walker, other than a statement related to corporate cash predictions, which is not related to the claimed embodiments of Applicants’ invention. Indeed, it is unclear how Walker addresses determining reward points based on a payment due date is related to predicting cash flow and capital. Accordingly, it appears the Examiner has improperly modified Walker without proper support from the reference or other teachings of the prior art. For at least these additional reasons, no *prima facie* case of obviousness has been

established with respect to claims 4, 6, 14, 16, 24, and 26 and is allowable over the cited art.

For at least the reasons stated above, Applicants submit that Walker does not teach or suggest all the elements of Applicants' claims 4-6, 14-16 and 24-26. Thus, the rejection of these claims under 35 U.S.C. S 103(a) should be withdrawn and the claims allowed.

### III. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1- 30 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 4, 6, 7, 11, 14, 16, 17, 21, 24, 26, and 27 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Indeed, as explained, the amendment to claims 1, 11, and 21 reflect recitations already considered by the Examiner with regard to dependent claims 4, 6, 14, 16, 24, and 26, for example. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow Applicants to reply to the final rejection and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

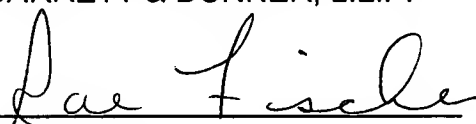
In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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